

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated September 09, 2004, in which:

- claims 1-3, 5, 6, 9-14, 16, 19, 21, 22, 24-26, 28, 30, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis *et al.* (hereafter, 'Lewis,' US Patent No. 6,385,388 B1) in combination with Hsu (US Patent No. 6,195,692 B1);
- and claims 4, 7, 8, 15, 20, 23, 27, 29, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis and Hsu in combination with DirectTV and Official Notice.

Reconsideration of the above referenced patent application in view of the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 3 month(s), including the appropriate fee, is filed herewith.

Claims 1-32 are now pending the above referenced patent application. No claims have been amended, cancelled, or added.

1. 35 U.S.C. § 103(a)

1.1. *Lewis and Hsu: Claims 1-3, 5, 6, 9-14, 16, 19, 21, 22, 24-26, 28, 30, and 31*

The PTO has also rejected claims 1-3, 5, 6, 9-14, 16, 19, 21, 22, 24-26, 28, 30, and 31 under 35 U.S.C. § 103(a) based upon Lewis in combination with Hsu. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

Applicant begins with claim 1. Claim 1 recites:

1. (Previously Presented) A method of providing content to a receiving device having an associated identifier associated with a network address for the receiving device, comprising:
 selecting a set of segments of content from a group of segments to be protected wherein the set does not include all segments of the group;
 protecting the segments of the set, but not the other segments of the group, to prevent the protected segments from being properly reproduced unless the protection is undone with assistance of a correct key that is not generally available and is based at least in part on the associated identifier; and
 providing access to the group of segments over a network.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

1.1.1. Undoing the Protection

It is respectfully asserted that neither Lewis nor Hsu, either alone or in combination, suggests or describes undoing the protection utilizing the correct key that is not generally available **and is based at least in part on the associated identifier**. The PTO asserts that the Lewis teaches this limitation in Fig. 11. However, it is respectfully asserted that Lewis does **not** teach this limitation. Lewis instead is mute on the form of the password. The PTO claims that the choice of what to base the password on is “a design choice.” Applicants respectfully assert that every element of a device or method is “a design choice,” and that being “a design choice” is not sufficient to meet the prima facie test for obviousness. Applicants respectfully assert that by attempting to broaden the obviousness test to include “a design choice” that the PTO is engaging in **impermissible hindsight**, which is forbidden under M.P.E.P. § 2145.X.A and *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Under the requirements for §103, the prior art reference (or references when combined) must teach or suggest all the claim limitations. It is respectfully asserted that Lewis does not show, teach, or suggest undoing the protection utilizing the correct key that is not generally available **and is based at least in part on the associated identifier**. Hsu does not cure this deficiency. Applicants respectfully request that if this rejection is maintained that the PTO cite exactly where (preferably by column and line) where Lewis explicitly teaches or suggests the use of the identifier in this manner.

Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

1.1.2. Receiving Device Identifier

It is respectfully asserted that neither Lewis nor Hsu, either alone or in combination, suggests or describes **a receiving device** having **an associated identifier associated with a network address**. The PTO asserts that the Hsu teaches this limitation. However, it is respectfully asserted that Hsu does **not** teach this limitation. Hsu instead uses a modem (Element 70, Fig. 2) which Hsu describes as a V.34 modem or ISDN line (Col. 5, lines 49-55). These devices do not traditionally have identifiers associated with them.

Further, the PTO states that “Hsu teaches ... providing content to a receiving device having an associated identifier associated with a network address (e.g. host name or web address which is associated with a network address like ip (sic) address).” It is respectfully asserted (in so far as Applicants understand the PTO’s statement) that Hsu does not do this. Hsu teaches receiving information from a **host device** that may have an identifier associated with a network address. But, Hsu never teaches nor suggests that **the receiving device** may have an identifier associated with a network address.

Under the requirements for §103, the prior art reference (or references when combined) must teach or suggest all the claim limitations. It is respectfully asserted that neither Lewis nor Hsu, either alone or in combination, suggests or describes a receiving device having **an associated identifier associated with a network address**. Applicants respectfully request that if this rejection is maintained that the PTO cite exactly where (preferably by column and line) where Hsu explicitly teaches or suggests the use of the receiving device having the identifier.

Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

1.1.3. Remaining Claims

Claims 2, 3, 5, 6, 9-14, 16, 19, 21, 22, 24-26, 28, 30, and 31 either depend from and include the limitations of claim 1, or include a substantially similar and patentably distinct limitation as claim 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

1.2. Lewis, Hsu, DirectTV, & Official Notice: Claims 4, 7, 8, 15, 20, 23, 27, 29, and 32

1.2.1. Official Notice

PTO's Official Notice of the use of "business choice" is respectfully traversed. Applicants request that the PTO furnish documentary evidence showing prior art that alone or in combination meets all the elements of the Applicants' claimed subject matter and showing why one skilled in that art would be motivated to combine the subject matter of the other cited art.

1.2.2. Remarks

The PTO has also rejected claims 4, 7, 8, 15, 20, 23, 27, 29, and 32 under 35 U.S.C. § 103(a) on Lewis and Hsu in combination with DirectTV. The rejection of these claims is also traversed.

Applicant begins with claim 4. Claim 4 recites:

1 4. (Original) The method of claim 3, wherein the remote computer number is a processor
2 number.

Claim 4 ultimately depends from the independent claim 3. Claim 3 recites:

1 3. (Previously Presented) A method of providing content, comprising:
2 selecting a set of segments of content from a group of segments to be protected wherein the set
3 does not include all segments of the group:
4 protecting the segments of the set, but not the other segments of the group, to prevent the
5 protected segments from being properly reproduced unless the protection is undone with
6 assistance of a correct key that is not generally available:
7 providing access to the group of segments over a network:
8 wherein selecting the set involves selecting at least some of the set for visual scrambling
9 and protecting the set includes visual scrambling those segments selected for visual scrambling;
10 and
11 wherein visual scrambling involves using a key, including a remote computer number.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Lewis, Hsu, DirectTV, nor the Official Notice, either alone or in combination, suggests or describes **utilizing a processor number as the remote computer number**.

DirectTV instead is mute on the form of the remote computer number or whether or not the remote computer has number. The PTO claims that the choice of what to base the password on is “a business choice.” Applicants respectfully assert that the PTO’s “business choice” test is incorrect for the same reasons as the “design choice” test described above, and the test is not sufficient to meet the *prima facie* test for obviousness. Applicants respectfully assert that by attempting to broaden the obviousness test to include “a design/business choice” that the PTO is engaging in **impermissible hindsight**, which is forbidden under M.P.E.P. § 2145.X.A and *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).


Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claims 7, 8, 15, 20, 23, 27, 29, and 32 either depend from and include the limitations of claims 4 or 1, or include a substantially similar and patentably distinct limitation as claim 4 or 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 4 or 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,


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